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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/886,685	06/21/2001	Barry H. Schwab	FNI-02204/03	8645

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EXAMINER

HANEY, MATTHEW J

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/886,685	SCHWAB ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew Haney	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of Washino (US 6,370,198 B1).

Although the conflicting claims are not identical, they are not patentably distinct from each other because it is considered obvious that one skilled in the art at the time of the invention would recognize the advantage of modifying the audio/video production system of the present application by incorporating the teaching of US Patent No. 6,370,198 B1. The motivation for performing such modification in the present application is to improve the processing capability and to increase the data transfer as taught by Washino (Column 6, Lines 61-67).

Claims 2-14 are rejected by dependency on claim 1.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaw (US 6,356,945 B1).

As for claims 1,7, 10, 13, 15-16, and 18, Shaw teaches of an audio/video production

system that comprises of a high-speed serial input for receiving an audio/video program and having an input format and an input frame rate (Note: high speed small computer system interface, Column 8, Lines 53-56); a serial-to-parallel converter in communication with the input for outputting the program onto a data bus (Note: converted from serial to parallel and decode the appropriate header, Column 8, Lines 31-35); a high capacity read/write medium interfaced to the data bus for storing at least

a portion of the audio/video program and a format converter interfaced to the data bus for outputting the audio/video program with an output format and output frame rate (Note: the video bus interconnects the frame memory with such components at the capture processor and the display processor (i.e. format converter), Column 7, Lines 22-28); a format converter interfaced to the data bus for outputting the audio/video program over a high-speed serial network (Column 3, Lines 20-32); and the equipment enables multiple users to access or manipulate the audio/video program (Note: the devices would interconnect with the multimedia communications assembly to allow the user/operator to control, complement and utilize the functions of the electronic devices by means of the multimedia communications assembly, Column 3, Lines 15-20).

As for claims 2 and 6, the use of a high-speed serial input conforming to the IEEE standard is considered as inherent and obvious to one of ordinary skill in the art because of its universal use as a high data throughput device.

As for claims 3-5, Shaw teaches of an input in an enhanced or high definition format (Column 3, Lines 40-54); wherein the program is output in an MPEG or Motion-JPEG format (Column 14, Lines 1-15); wherein the program is output in a high-speed serial form (Note: the small computer interface is readily available and capable of providing high speed interface between the internal system bus and the external host, Column 15, Lines 41-44).

As for claims 8-9, and 17, Shaw teaches of equipment that facilitates streaming video (i.e. in real time) over the Internet or other network (Column 8, Lines 66-67 and

Column 9, Lines 1-10); and wherein the equipment provides archival storage (i.e. old frames) of the audio/video program (Column 11, Lines 32-41).

As for claims 11-12, and 14, Shaw teaches of multiple format converters, each interfaced to the data bus (Column 3, Lines 40-54); a digital effects unit for manipulation of the audio and/or video portions of the program (Column 3, Lines 15-20, and Column 14, Lines 12-16); wherein the input and output frame rates are 24, 25, or 30 frames-per-second, or any integer multiple or integer fraction thereof (Column 6, Lines 23-27).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shaw (US 5,706,290) discloses an audio/video processor with control functions capable of conversion with HDTV, MPEG, JPEG, etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Haney whose telephone number is 703-305-4915. The examiner can normally be reached on M-Th (7-4:30), Every Other Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 703-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew Haney  
Examiner  
Art Unit 2613

mjh

  
CHRIS KELLEY  
SUPERVISORY PATENT EXAMINER  
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